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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,125	07/17/2003	Lisa Corcoran	021919-000810US	4472
20350	7590	04/07/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ALIE, GHASSEM	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,125

Applicant(s)

CORCORAN ET AL.

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 11 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11, and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/17/03(1, 2 4-14)&02/23/04(3) is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of species III (Fig. 2B) on 12/19/05 is acknowledged. The traversal is on the ground(s) that that limitations in claim 1 are generic to Figs. 2B, 2C, 2D and as well as the non-numbered figure on page 2 of the drawings. It should be noted that generic claims permit rejoinder of a reasonable number of claims if one or more generic claims are found to be allowable. However, applicant's independent claim 1 is not generic to the species in Figs. 2B, 2C, 2D and as well as the non-numbered figure on page 2 of the drawings. In order to be generic a claim must comprehend within its confines the organization covered in each of the species. This is not possible here. For example, one species in Fig. 2B includes a consumer die, a separate pad, and a separate adaptor; other species in Fig. 2D includes a chemical etched die and a combination of pad and adaptor; and another species in non-numbered figure on page 2 of the drawings includes a specific adaptor 1300, a consumer die and another adaptor. While the broad claims may be broad enough to encompass several species they are not generic as defined by MPEP 806.04(D). Nevertheless, if an independent or superior claim that encompasses other claimed species is allowed, rejoinder will be permitted as long as there is compliance with respect to 35 U.S.C., 2<sup>nd</sup> paragraph.

The requirement is still deemed proper and is therefore made FINAL.

2. No claim is withdrawn, since non-elected claims have been cancelled and current pending claims 1, 11, and 18-20 read on the elected specie III (Fig. 2B).

Claims 2-10 and 12-17 have been canceled.

***Drawings***

3. The drawings are objected to because a figure in page 2 is not numbered. It should be noted that all the similar figures in page 2 are numbered except the figure at top right corner of the page 2. This non-numbered figure should be numbered in order to be consistent with other figures in page 2.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

4. Claim 20 is objected to because of the following informalities: "thickness between 0.312 and 0.317 inches" should be --thickness between 0.312 to 0.317 inches--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 11, and 18-20, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding Claim 1, “a commercial die press including a working area with a cutting height; a die adapted to be located in the cutting area of a consumer press” is confusing. It is not clear whether a commercial die press or a consumer die press is claimed. It appears that claim 1 set forth a system that includes a commercial die press, a commercial die, a die, and a consumer die. However, no relation has been established between the commercial die press and the consumer press in either the claims or the specification. It is not clear how the commercial die press and the consumer press are interrelated in the system. It is suggested that the applicant claim the characteristics or limitations of the consumer press, which appears to be the invention of the instant application, rather than claiming both a commercial die press and a consumer press in the same claim. In addition, “the consumer press with a cutting height smaller than the cutting height of the commercial press” is confusing. It is not clear what is the exact cutting height of the commercial press. It is not clear what is the difference between a commercial die press and a consumer die press. It is not clear what encompasses a commercial die press or what encompasses a consumer press. In addition, the cutting heights of commercial presses are varied and all the commercial presses do not have the same cutting height. Is applicant suggesting that all the commercial presses have same cutting height? A commercial die press

can have a cutting height that could be smaller or larger than some other commercial die presses. Regarding claim 11, it is clear how the first die press relates to a press in the die press system. It not clear, what is a purpose of having a first die press and how the first die press works in the die press system or completes the die press system. It appears that the first die press is a separate unit which has nothing to do with the press.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 11, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Beijen (5,778,748). Regarding claim 11, Beijen teaches a die press system that includes at least two die presses. One of the die presses can be considered as a “commercial die press.” and the other can be considered as a “consumer die.” It should be noted that Beijen teaches that the die press has a paten assembly 40 that includes a lower plate 42 and a resilient pad 44. Beijen also teaches that the resilient pad 44 could be directly attached to the base plate 22 in one embodiment or a second die press, and the resilient pad 44 can be attached to the lower plate 42 in a second embodiment or the first die press. It should be noted that the second die press is considered to be a commercial die press and the first die press is considered to be the consumer die press. It should also be noted that the cutting area of the second die press or the consumer die press is smaller than the cutting height of the commercial die press. Beijin also teaches a die 30 having a height configured for the first

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cutting height. It should be noted that the die 30 is configured for the height of the first die press or the consumer die press. Bejin also teaches a cutting pad 44 and an adapter 42 configured for use with die 30 and the cutting pad 44 to enable use of the die 30 in a press having a second cutting die height, wherein the second cutting height is larger than the first cutting height. It should be noted that the first die press is defined as the press that has a second cutting height which is larger than the cutting height of the second die press.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negative by the manner in which the invention was made.

10. Claims 19 and 20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bejin. Regarding claims 11 and 20, Bejin teaches everything noted above, but Bejin does not expressly teach that the height of the die is 0.616 to 6.68 and the thickness of the cutting pad is 0.312 and 0.317 inches. However, it appears that die 30 has a height in a range of 0.616 to 0.628 inches and the cutting pad 44 has a thickness in a range of 0.312 to 0.317 inches. In addition, the use of die and cutting pad with the specific heights as claimed is well known in the art. Further more, it would have been obvious to a person of ordinary skill in the art to choose the height of the die and the height of the cutting pad within the specific claimed range, in order to fit the die within the specific cutting height of the press.

11. Claims 1, 11, and 18, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Beijen. Regarding claims 1 and 11, Regarding claim 1, Beijen teaches a die press system that includes at least two die presses. One of the die presses can be considered as a “commercial die press.” and the other can be considered as a “consumer die.” Beijen teaches that the die press has a paten assembly 40 that includes a lower plate 42 and a resilient pad 44. Beijen also teaches that the resilient pad 44 could be directly attached to the base plate 22 in one embodiment or a first die press, and the resilient pad 44 can be attached to the lower plate 42 in a second embodiment or the second die press. It should be noted that the first die press is considered to be a commercial die press and the second die press is considered to be the consumer die press. The cutting area of the second die press or the consumer die press is smaller than the cutting height of the commercial die press. Beijen also teaches an adapter 42 having a thickness or height that is generally approximately equal to the difference between the cutting height of the first die press or the commercial die and the height of the second die press or the consumer press. Beijen does not expressly teach that the adapter has a thickness or height that is generally approximately equal to the difference between the height of a commercial die or and the die. However, it should be noted that commercial press does not have the adapter 42. Therefore, the thickness of the die that is used with the commercial press or the similar press, which has a larger cutting height, naturally could be larger than the thickness of the consumer die. It should also be noted that the adapter 42 compensates for the height difference between the die and the commercial die. Therefore, it would have been obvious to a person of ordinary skill in the art to provide Beijen’s commercial die with a die which has a larger thickness than the thickness of the die



in order to cut a specific material with a specific thickness. In addition, it should be noted that the die could have different thicknesses, and naturally there are dies that can fit within the cutting height of the commercial press, but they cannot fit within the cutting height of a consumer die press. It would have been obvious to a person of ordinary skill in the art to use the adapter 42 with the die having a smaller thickness in order to fit the die within the cutting height of the commercial die press that has a larger cutting height.

### ***Response to Amendment***

12. Applicant's arguments filed on 12/19/05 have been fully considered but they are not persuasive.

Applicant's argument that Beijen does not teach two different die presses is not persuasive. Beijen teaches a die press system that includes at least two die presses. One of the die presses can be considered as a "commercial die press." and the other can be considered as a "consumer die." Beijen teaches that the die press has a patent assembly 40 that includes a lower plate 42 and a resilient pad 44. Beijen also teaches that the resilient pad 44 could be directly attached to the base plate 22 in one embodiment or a first die press, and the resilient pad 44 can be attached to the lower plate 42 in a second embodiment or the second die press. It should be noted that the first die press is considered to be a commercial die press and the second die press is considered to be the consumer die press. The cutting area of the second die press or the consumer die press is smaller than the cutting height of the commercial die press.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to

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applicant's disclosure.

Paphael et al. (3,396,620), Leslie (2,260,183), Corcoran et al. (6,945,166), Strobel (3,673,902), BERLIN (3,150,550), Stranad (3,062,083), and O'Connor (3,281,343) teach a die press having a die.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).

GA/ga

March 29, 2006



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